

REMARKS

Upon entry of this amendment, claims 1, 5 and 10-15 will be canceled without prejudice or disclaimer of the subject matter recited therein, and claims 2, 6 and 7 will be amended, whereby claims 2, 6-9 and 16-19 will be pending

By the amendment herein, independent claims 6 and 7 have been amended, as discussed with the Examiner during a telephone interview that will be discussed below, to include the elected species of 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid (AM80) and to delete prophylactic. Moreover, independent non-elected claim 1 has been canceled, dependent claim 2 has been amended to delete prophylactic, and dependent claims 10-15 have been canceled in conformance with amendments made to the independent claims. Applicants note that these amendments have been made without prejudice or disclaimer and preserving Applicants' right to file one or more continuation and/or divisional applications directed to canceled/deleted subject matter, and to present argument for patentability if rejections are raised.

Reconsideration and allowance of the application are respectfully requested.

Statement of Interview

Applicants express appreciation for the courtesies extended by Examiner Umamaheswari Ramachandran during an October 27, 2010 telephone interview with Applicants' representative Arnold Turk.

During the interview, amendment of independent claim 7 was discussed to recite the elected species of 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid (AM80) and to delete the prophylactic language. The Examiner agreed that such

amendment should lead to withdrawal of the rejections under 35 U.S.C. 112, first and second paragraphs.

With respect to the obviousness rejection based upon U.S. Patent No. 5,965,606 to Teng et al. (hereinafter "Teng") and Goodman (PNAS, 2003, 100, 5, 2901-05) and Etchamendy (J Neuosci, 2001, Aug 21(16) p 6423-29), Applicants' representative referred the Examiner to Applicants' originally filed application wherein Etchamendy is discussed and contrasted in Applicants' at page 2, lines 12-15. It was pointed out that Etchamendy may suggest suppression of reduction of already consolidated long-term memory by retinoic acid, but does not teach or suggest any action of retinoic acid on the consolidation process of short-term to long-term memory. Moreover, it was noted that it appears that while Teng broadly discloses a generic formula that encompasses Am80, it does not provide explicit disclosure of Am80. Moreover, Applicants' representative noted that Teng broadly discloses many uses for retinoic acid, but does not provide guidance for arriving at Applicants' claimed subject matter. Still further, it was argued that Goodman does not overcome the deficiencies of either Teng or Etchamendy or any combination thereof.

The Examiner indicated that independent claim 7 as amended herein should be in condition for allowance subject to further search and consideration, and that Applicants' statement of the interview can specifically state that the Examiner indicated that amended independent claim 7 and the claims dependent therefrom are allowable over the prior art of record.

Additionally, during a November 3, 2010 telephone call, Examiner Umamaheswari Ramachandran indicated to Applicants' representative Arnold Turk that other species, such as 4-

[(3,5-bis-trimethylsilylphenyl)carboxamido]benzoic acid recited in dependent claim 5, remain non-elected.

English Translation of Provisional Application

Applicants are concurrently filing herewith a statement to confirm the filing of the accurate English translation of provisional Application No. 60/622,618 from which priority is claimed.

Consideration OF Information Disclosure Statements

Applicants express appreciation for the inclusion with the Office Action of a signed copy of the Form PTO-1449, whereby the Examiner's consideration of the Information Disclosure Statement filed May 26, 2009 and June 8, 2007 is of record.

Applicants have also submitted a Second Supplemental Information Disclosure Statement on July 13, 2010. The Examiner is requested to confirm consideration of the Second Supplemental Information Disclosure Statement and the information cited therein by including an initialed copy of the form submitted therewith with the next communication from the Patent and Trademark Office.

Claim Of Foreign Priority

Applicants request that the Examiner confirm receipt of the certified copy of the foreign priority application in this national stage application.

Response To Maintaining Of The Restriction Requirement

Applicants' election with traverse of Group III, claims 2, 5 and 7-19 is acknowledged along with the species of AM80. The requirement has been made final and claims 2, 5, 7-9, 13-16, 18 and 19 are indicated to be readable upon the elected species and examined on the merits, and claims 1, 6, 10-12 and 17 are indicated to stand withdrawn from consideration.

In response, Applicants note that an interview with the Examiner actually was conducted on April 12, 2010 and not April 14, 2010 as indicated in the Office Action.

Additionally, to reduce issues non-elected claim 1 has been canceled without prejudice to the filing of the canceled subject matter in one or more divisional and/or continuation applications.

Moreover, non-elected species have been deleted without prejudice to filing one or more divisional applications to the non-elected species.

Moreover, as noted above, non-elected independent claim 6 has been amended in a similar manner to independent claim 7. Applicants request that non-elected claims 6 and 17 be rejoined upon allowance of the elected subject matter.

Response To Objection To Specification

In response to the objection to the specification for a typographical error in the disclosure of Am80 in Table 2, Applicants note the following.

Am80 is included in Table 2. However, its inclusion is presented in two lines. Therefore, Table 2 has been reformatted to show Am80, Tac101 and HX630 all in one line.

Accordingly, the objection should be withdrawn.

Response To Rejections Under 35 U.S.C. 112, First And Second Paragraphs

Claims 2, 5, 7-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The rejection contends that that the recitation of "prophylactic" is not clear because usually the term is used to prevent an occurrence.

Claims 2, 5, 7-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as not being enabling for prophylactic treatment of dysfunction of promoting memory comprising administering Am80.

Claims 2, 5, 7-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, while being enabling for some compounds of non-natural retinoids having a basic skeleton comprising an aromatic ring bound with an aromatic carboxylic acid or tropolone bound by a bridging group does not reasonably provide enablement for the compounds encompassed by the claims.¹

With respect to these ground of rejection, Applicants again note that "prophylactic" language has been deleted from the claims. Moreover, the claims have been amended to be directed to the elected species. Accordingly, the rejections are moot and should be withdrawn. However, Applicants note that the amendment herein has been made to advance the application to allowance and is made without expressing and agreement or acquiescence with the rejections of record. In this regard, Applicants preserve the right to submit one or more continuation and/or divisional applications directed to the deleted/canceled subject matter, and to present arguments for patentability in the event that such subject matter is subjected to rejection.

¹ The rejection incorrectly includes claims therein that are directed to a sub-genus and specific species, such as claims 13 and 14.

Response To Rejection Based Upon Prior Art

Claims 2, 5, 7-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,965,606 to Teng. and Goodman (PNAS, 2003, 100, 5, 2901-05) and Etchamendy (J Neuosci, 2001, Aug 21(16) p 6423-29).

In response, Applicants note that during the above-noted interview the Examiner agreed that the disclosures of Teng, Goodman and Etchamendy are not combinable to arrive at the subject matter recited in Applicants' independent claim 7 and further patentably defined in the claims depending therefrom. In this regard, as noted in the Statement of Interview, the Examiner agreed during the interview that one having ordinary skill in the art would not have combined Teng, Goodman and Etchamendy to arrive at a method for promoting memory consolidation, comprising administering to a mammal in need thereof a therapeutically effective amount of a composition to promote memory consolidation, the composition comprising 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid as an active ingredient.

Accordingly, withdrawal of the rejection of record with allowance of the application is respectfully requested.

Further, Applicants note that the amendment herein has been made to advance the application to allowance and is made without expressing and agreement or acquiescence with the obviousness rejection of record. In this regard, Applicants preserve the right to submit one or more continuation and/or divisional applications directed to the deleted/canceled subject matter, and to present arguments for patentability in the event that such subject matter is subjected to rejection.

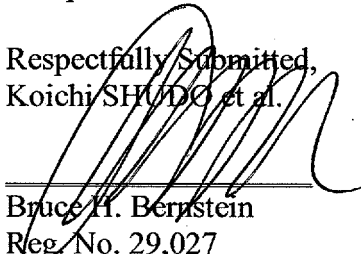
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement, objection and rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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